

REMARKS/ARGUMENTS

This Amendment is in response to the Final Office Action mailed November 13, 2008.

Claims 1-52 are pending in the present application. Reconsideration and allowance are requested.

Claim Rejection under 35 USC 102

In the Office Action, claims 1-11, 15-28, 32-45, and 49-52 were rejected under 35 U.S.C. § 102(e) as being anticipated by Hind et al (U.S. Publication No. 2004/0205555) (hereinafter "Hind"). The Applicant respectfully traverses. The standard for anticipation is set forth in M.P.E.P. § 2131 as follows:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).... "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Applicant submits that claims 1-11, 15-28, 32-45, and 49-52 are patentable over Hind because each and every element set forth in the claims is not expressly or inherently described in Hind.

In the previous response to Office Action filed August 11, 2008, the Applicant provided several reasons why Hind does not anticipate the claimed invention. In the latest Office Action, the Examiner responded that the Applicant's arguments were fully considered but they are deemed not persuasive. In this response to Office Action, the Applicant further explains why claims 1-11, 15-28, 32-45, and 49-52 are patentable over Hind.

Claim 1 clearly and unambiguously recites "determining if the portion of the first information requested by the first request is accessible to the note-taking device." The Applicant submits that Hind fails to teach or suggest the "*determining...*" feature recited in claim 1. Moreover, the Applicant submits that Hind fails to teach anything that resembles determining whether information is accessible to a note-taking device, as required by claim 1. Assuming

arguendo, the portal page is the note-taking device, as asserted by the Office Action, then the portal page does not determine if the portion of the first information requested by the first request is accessible to it. Instead, Hind assumes that the portion of the first information requested by the first request is accessible to the portal page and pushes that information onto the portal page. Hind does not even consider the possibility that the portal page is accessible and pushes the information onto the portal page without making any determination of the portal page's accessibility. Hind only appears to consider the scenario where the server is not ready to deliver the information but the portal page is always accessible and waiting to receive the information. When the portal page does not receive the information the portal page displays a place holder. For example, in paragraph [0030], Hind discloses that subsequent refresh requests are sent automatically, without ever considering the possibility that the note-taking device or portal page is accessible:

When a browser supporting refresh headers receives a document which has a refresh header, the browser automatically sends a subsequent request for refreshed content after waiting for the specified time (in seconds). The server receiving the subsequent request then returns the content, and that content is used to repaint the screen (in a visual rendering), overlaying the previous content.

The Applicant submits that determining whether the server is ready to deliver information to the portal page is not the same as determining if information is accessible to the portal page. In other words, determining that the server is not ready to deliver the information and therefore only displaying a place holder until the server is ready to deliver the information is not the same as determining if the information is accessible to the portal page. In the Office Action, the Examiner asserted:

[a]s to the argument that Hind determines only what is accessible to the server and not to note-taking device, the Examiner respectfully asserts, without conceding to the presented interpretation of Hind, that whatever is not available to the portal server is accordingly inaccessible to the note-taking device.

The Applicant believes that Hind does not address the situation where the portal server is not accessible to receive information but rather only the situation where the portal

server is not ready to deliver information. In Hind, the portal server may, or may not be, ready to deliver information but the note-taking device is always ready to receive information and is just waiting for the portal server to push that information onto it. This is different than claim 1 which recites "**determining if the portion of the first information requested by the first request is accessible to the note-taking device.**" The possibility that the portal server is not ready to deliver information has nothing to do with determining whether the note-taking device is accessible.

Further evidence that Hind does not need to **determine** if the portion of the first information requested by the first request **is accessible to the note-taking device**, is found in paragraphs [0031]-[0033], where refreshing requests are repeated, automatically, until all of the information for a complete portal page is complete. In paragraph [0033], Hind teaches "[t]his process repeats until all content is ready; when the portal has a complete portal page for returning to the browser, the refresh header is omitted." The possibility that a portal page will not be completed because it is not accessible is not even contemplated because the possibility that the information being sent to the portal page will not be accessible is not an option. In paragraphs [0031]-[0033] and figs. 2A-2C, 3A, and 3B, Hind teaches that the screen refresh is done automatically until the screen is completely refreshed. Again, the possibility of the portal page not being accessible and the complete page not being displayed because the portal page is not accessible is not considered. Therefore, the Applicant believes that Hind fails to teach or suggest "determining if the portion of the first information requested by the first request is accessible to the note-taking device," as recited in the claims.

Claim 1 also recites "storing the first request in the notes document upon determining that the portion of the first information requested by the first request is not accessible to the note-taking device." The Office Action asserts that Hind discloses this limitation in paragraphs [0031]-[0033] and in Figure 3A. The Applicant respectfully disagrees. In the previous response to Office Action, the Applicant explained that Hind does not teach or suggest the "*storing* . . ." feature recited in claim 1 and further that Hind does not teach this limitation in paragraphs [0031]-[0033] and in Figure 3A, as asserted by the Office Action. The latest Office Action responded by maintaining its previous position.

The Applicant submits that Hind still fails to teach or suggest the "*storing...*" feature recited in claim 1, but instead, Hind only appears to teach **displaying** a place holder while the screen is refreshed. Hind does not appear to teach anything that resembles "*storing*" a request. For example, in paragraph [0032] as well as Figure 3A, Hind appears to only teach that place holder is displayed until the remainder of the information can be retrieved. Specifically, paragraph [0032] states:

[0032] Note that the placeholder message displayed instead of portlet content at 320 is merely one way in which absence of a portlet's content can be indicated. Alternatives include displaying an image to fill the space; displaying a message reflecting the portlet's purpose (which may be obtained programmatically from the portlet's properties interface, for example); and leaving the space unoccupied. (When the portlet content eventually arrives and is painted in its place on the portal page, the user ideally will perceive that the portlet's area of the portal page is simply being repainted with its content, rather than the entire page being repainted.)

Clearly, Hind only teaches that a place holder is displayed until all of the information can be downloaded. The Applicant submits that "displaying a place holder" is not the same as "*storing the first request....*" Those skilled in the art will realize that displaying involves generating an image that is displayed or shown to a user whereas storing involves recording for some later use. Thus, Hind does not teach or disclose "*storing the first request in the notes document upon determining that the portion of the first information requested by the first request is not accessible to the note-taking device,*" as recited in the claims.

Therefore, each and every element of claim 1 is not found, either expressly or inherently described, in Hind. In light of the above, Applicant submits that claim 1 is not anticipated by Hind under M.P.E.P. § 2131. Applicant thus submits that claim 1 is in condition for allowance.

Claims 2-11, 15-28, 32-45, 49-52

The Applicant submits that independent claims 18, 35, and 52 are patentably distinguishable and allowable over Hind for at least a similar rationale as discussed above for the allowability of claim 1.

The Applicant further submits that dependent claims 2-11, 15-17, 19-28, 32-34, 36-45, and 49-51, which depend either directly or indirectly from claims 1, 18, 35, respectively, are allowable in light of Hind for at least a similar rationale as discussed above for the allowability of the independent claims. The dependent claims are also allowable for additional reasons.

Claim Rejection under 35 USC 103

In the Office Action, claims 12-14, 29-31, and 46-48 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hind et al. and Chiu et al (U.S. Patent No. 6,452,615) (hereinafter "Chiu"). In rejecting claims 12-14, 29-31, and 46-48, the Office Action acknowledged that Hind fails to teach wherein the first information comprises information captured during a first presentation and wherein the portion of the first information is a slide displayed during the first presentation. The Office Action then used Chiu to make up these deficiencies by arguing that "Chiu teaches a method of creating information comprising captures from presentation for insertion in a note document (Chiu, abstract and col. 3, lines 22-57). The information includes slides, audio segments, video segments, and images displayed during the presentation (Chiu, col. 4, lines 47-60; col. 5, lines 8-20; col. 3, lines 22-57; see figs. 3 and 7)."

The Applicant respectfully traverses. Claims 12-14 depend from claim 1. As discussed above, claim 1 is not anticipated by Hind. Further, the Applicant submits that the deficiencies of Hind with respect to claim 1 are not cured by Chiu. For example, the Applicant submits that Chiu fails to teach the "*determining . . .*" and "*storing . . .*" features recited in claim 1. For further details of this discussion, please see the Applicant's response filed on February 13, 2008 (responsive to the Office Action dated December 13, 2007). The Applicant thus submits that even if Hind and Chiu were combined as suggested by the Office Action (even though there

appears to be no motivation for the combination), the resultant combination would not render claim 1 obvious. Consequently, claims 12-14 that depend from claim 1 are also not rendered obvious by a combination of Hind and Chiu for a similar rationale as discussed for claim 1. The dependent claims are also patentable for additional reasons.

The Applicant submits that dependent claims 29-31 and 46-48 are allowable over a combination of Hind and Chiu for at least a similar rationale as discussed above for the allowability of claims 12-14. The dependent claims are also patentable for additional reasons.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

/Jesus Del Castillo/

Jesus Del Castillo
Reg. No. 51,604

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 650-326-2400 / Fax: 415-576-0300
JDC:gjs
61710309 v1